

*Amendment I, Responsive to 31 May 2006 action*Appl. no. 09/670,705  
Atty. ref. IG012a0fUS**REMARKS**

The action rejects the claims as being obvious over the combination of Glover and Battersby. The Applicant respectfully traverses the rejection. The Applicant has also added new claims 41 and 42 that define the structure of the notches into which the primary sealant is applied. The combination of references does not disclose, teach, or suggest the steps of applying a primary sealant to notches in the manner recited in claims. The use of the tapered notches as recited in claims 41 and 42 allows the primary sealant to fill the notches while minimizing the creation of air bubbles which degrade the strength of the seal being formed by the primary sealant. None of the references disclose, teach, or suggest the use of tapered notches in a foam-bodied spacer member to receive beads of primary sealant. Further, Glover does not disclose the claimed method because Glover only uses pre-applied sealant in notches. When the sealant is applied to the corners of the channel, Glover teaches away from the use of notches. The Applicant thus submits one of ordinary skill in the art at the time of the invention would not have been led to make the combination presented in the action because Glover teaches away from the use of notches when applying sealant to a channel disposed outwardly of the spacer. The embodiment of Fig. 2A of Glover '217 discloses a spacer frame configuration having the sealant (44) filling in the notches (Col. 8, line 67) before the spacer is sandwiched between the glass sheets. This glazing unit is then passed through a heated roller press to wet out the sealant (44). This application of the sealant (44) in the Fig. 2A embodiment of Glover '217 is thus opposite to the method recited in independent claim 32 wherein the primary sealant is applied to the notches after the spacer frame is secured to the glass sheets. Glover's Fig. 2B shows the alternative wherein the sealant is applied as a fillet at the corner of the spacer and the glass. Glover thus teaches away from the method recited in the claims. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966) ("known disadvantages in old devices which would naturally discourage the search

*Amendment I, Responsive to 31 May 2006 action*

Appl. no. 09/670,705  
Atty. ref. IG012a0fUS

for new inventions may be taken into account in determining obviousness"). *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Glover teaches away from the claimed method and thus does not include the teaching, suggestion, or motivation required to establish a *prima facie* case of obviousness. Further, Glover and Battersby do not disclose the use of tapered notches being filled with primary sealant independent of a sealant that extends across the channel as recited in the claims.

The Applicant submits the dependent claims are independently patentable. Inquiries concerning this submission should be directed to the attention of the undersigned.

Respectfully submitted,



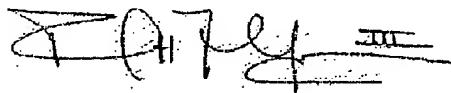
November 30, 2006

Fred H. Zollinger III, Reg. No. 39,438  
Attorney for Applicant

Zollinger & Burleson Ltd.  
P.O. Box 2368  
Canton, Ohio 44720-0368  
phone: 330/526-0104, x1  
facsimile: 866/311-9964

Certificate of Mailing/Facsimile

I hereby certify that this correspondence (Amendment I) is being transmitted by facsimile to (571) 273-8300 on November 30, 2006.



---

Fred H. Zollinger III, Reg. No. 39,438